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Date: August 6, 2009

Name: John C. Freeman, Esq.

Signature: 

PATENT  
CASE NO. 10022/580

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application: )  
 )  
Roland Hengerer )  
 ) Group Art Unit: 2857  
Serial No.: 10/766,738 )  
 ) Examiner: Desta, Elias  
Filed: January 27, 2004 )  
 ) Confirmation No. 2842  
Patent No.: 7,565,273 )  
 )  
Issued: July 21, 2009 )  
 )  
For: DETERMINATION OF THE AGE, )  
 IDENTIFICATION AND SEALING )  
 OF A PRODUCT CONTAINING )  
 VOLATILE COMPONENTS )

**REQUEST FOR RECONSIDERATION OF**  
**PATENT TERM ADJUSTMENT**  
**PURSUANT TO 37 C.F.R. § 1.705(d)**

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

U.S. Patent No. 7,565,273 ("the '273 patent") issued on July 21, 2009. Pursuant to 35 U.S.C. § 154(b), the United States Patent and Trademark Office ("the PTO") calculated a patent term adjustment of 682 days. The PTO's Patent Application Information Retrieval (PAIR) system and an Issue Notification mailed by the PTO on July 1, 2009 both indicate a patent term adjustment, which was calculated by the PTO pursuant to 37 C.F.R. §1.701, of **six hundred**

**eighty two (682)** days. A copy of the Issue Notification for the '273 patent is included herewith as Exhibit A.

The PTO calculated the patent term adjustment for the '273 patent based on activities and associated dates detailed in the Patent Application Information Retrieval (PAIR) system's Patent Term Adjustment History, attached as Exhibit B. Applicant believes that errors and/or omissions in the calculation have resulted in an incorrect patent term adjustment for the '273 patent as described in detail below. Pursuant to 37 C.F.R. § 1.705(d), Applicant files this request for reconsideration within two months of the issue date of the '273 patent. Note that the '273 patent is not subject to a terminal disclaimer.

**Increase in Period of Adjustment pursuant to 37 C.F.R. § 1.704**

**Period of adjustment pursuant to 37 C.F.R. § 1.703(a)(1)**

The period of adjustment pursuant to 37 C.F.R. § 1.703(a)(1) is the number of days in the period beginning on the day ("the 14 month date") after that date that is fourteen months after the date on which the application was filed pursuant to 35 U.S.C. § 111(a), or fulfilled the requirements pursuant to 35 U.S.C. § 371, and ending on the date of mailing or either an action pursuant to 35 U.S.C. § 132 or a notice of allowance pursuant to 35 U.S.C. § 151, whichever comes first. Applicant agrees with the calculated delay of **seventy one (71)** days as reflected in the PAIR system's Patent Term Adjustment History, attached as Exhibit B.

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Period of adjustment pursuant to 37 C.F.R. § 1.703(a)(2)

The period of adjustment pursuant to 37 C.F.R. § 1.703(a)(2) is the number of days in the period beginning on the day (“the 4 month date”) after the date that is four months after the date a reply under 37 C.F.R. § 1.111 was filed and ending on the date of mailing of either an action under 35 U.S.C. § 132, or a notice of allowance under 35 U.S.C. § 151, whichever occurs first.

In the present application, Applicant filed a Notice of Appeal and a Pre-Appeal Brief Request for Review via Express Mail on **April 13, 2007** as evidenced by the Image File Wrapper document attached as Exhibit C. Therefore the 4 month date for receiving an Office Action should prosecution be reopened was **August 13, 2007**. A Notice of Panel Decision from Pre-Appeal Brief Review was mailed in response to the Pre-Appeal Brief Request for Review on June 19, 2007. The Notice of Panel Decision reopened prosecution. An Office Action was subsequently mailed on **October 3, 2007** as evidenced by the Image File Wrapper document attached as Exhibit C. Applicant agrees with the calculated delay of **fifty one (51)** days as reflected in the PAIR system’s Patent Term Adjustment History, attached as Exhibit B.

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Period of adjustment pursuant to 37 C.F.R. § 1.703(b)

The period of adjustment pursuant to 37 C.F.R. § 1.703(b) is the number of days in the period beginning on the day (“the 3 year date”) after the date that is three years after the date on which the application was filed pursuant to 35 U.S.C. § 111(a) and ending on the date a patent was issued, but not including pursuant to 37 C.F.R. § 1.703(b)(1) the number of days, if any, in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. § 132(b) was filed and ending on the date a patent was issued.

The present application was filed on **January 27, 2004** as evidenced by the official filing receipt attached as Exhibit D. The 3 year date determined pursuant to 37 C.F.R. § 1.703(b) is January 27, 2007. During prosecution of the application, a Request for Continued Examination was filed via Express Mail on **January 22, 2009** as evidenced by the Image File Wrapper document attached as Exhibit C. The ‘273 patent was granted on **July 21, 2009** as evidenced by the Issue Notification document attached as Exhibit A. When discounting 1) the 51 days of overlapping delay caused by the U.S. Patent Office for not timely responding to Applicant’s Office Action mailed on April 13, 2007 mentioned previously and 2) the days contained in the time frame from the January 22, 2009 filing of the Request for Continued Examination to the July 21, 2009 date of grant of the ‘273 patent, Applicant respectfully submits that the non-overlapping period of adjustment beyond the 3 year date is **six hundred seventy five (675)** days, under 37 C.F.R. § 1.703(b).

As indicated by the PAIR system's Patent Term Adjustment History, attached as Exhibit B, the three year delay by the PTO pursuant to 37 C.F.R. § 1.703(b) was **six hundred four (604)**. However, that period of adjustment has been improperly reduced by **seventy one (71)** days, the amount of delay caused by the PTO pursuant to 37 C.F.R. § 1.703(a)(1) as mentioned previously. The PTO's calculation is based on its position that prior delays by the PTO that subsequently caused a three year delay are to be treated as an overlap of delay that cannot be counted twice pursuant to 37 C.F.R. § 1.703(f). Thus, the PTO's position is that the **seventy one (71)** days of delay caused by the PTO pursuant to 37 C.F.R. § 1.703(a)(1) caused the subsequent three year delay and so is an "overlapping" delay. Consequently, the PTO has reduced the total three year delay by **seventy one (71)** days. The PTO's manner of calculation is contrary to rule 37 C.F.R. § 1.703(f) and the statute, 35 U.S.C. § 154(b)(2)(A). See *Wyeth et al. v. Dudas*, 88 USPQ 2d 1538 (D.D.C. 2008) (Exhibit E). Accordingly, Applicant respectfully requests that the PTO correct the patent term adjustment to include the **seventy one (71)** days of non-overlapping adjustment.

**Reduction in Period of Adjustment pursuant to 37 C.F.R. § 1.704**

**Period of adjustment pursuant to 37 C.F.R. § 1.704(b)**

Pursuant to 37 C.F.R. § 1.704(b), the period of adjustment shall be reduced by the number of days, if any, beginning on the day after the date (the 3 month date) that is three months after the date of mailing or transmission of an Office communication notifying the applicant of a rejection, objection, etc., and ending on the date a corresponding reply was filed.

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In the present application, an Office Action was mailed on **December 19, 2005** as evidenced by the Image File Wrapper document attached as Exhibit C. Therefore the 3 month date for filing a reply was **March 19, 2006**. A Notice of Appeal was filed via Express Mail on **March 20, 2006** in response to the Office Action as evidenced by the Image File Wrapper document attached as Exhibit C. Applicant agrees with the calculated delay of one (1) day as reflected in the PAIR system's Patent Term Adjustment History, attached as Exhibit B.

An Office Action was mailed on **October 3, 2007** as evidenced by the Image File Wrapper document attached as Exhibit C. Therefore the 3 month date for filing a reply was **January 3, 2008**. A Notice of Appeal was filed via first class mail on **January 3, 2008** in response to the Office Action. The Notice of Appeal was received by the U.S. Patent Office on **January 7, 2008** as evidenced by the Image File Wrapper document attached as Exhibit C. Applicant agrees with the calculated delay of four (4) days as reflected in the PAIR system's Patent Term Adjustment History, attached as Exhibit B.

A Notice of Allowance was mailed on **March 13, 2009** as evidenced by the Image File Wrapper document attached as Exhibit C. The Notice of Allowance included a Notice of Allowability that included a paragraph 2 that contained the Examiner's reasons for allowance of the claims. The Examiner at paragraph 3 of the Notice of Allowability invited comments from the Application regarding the reasons for allowance. Therefore the 3 month date for filing comments regarding the reasons for allowance was **June 13, 2009**. A Response to Notice of Allowance that

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included Applicant's comments regarding the Examiner's reasons for allowance was filed via first class mail on **June 9, 2009** in response to the Office Action. The Response to Notice of Allowance was received by the U.S. Patent Office on **June 15, 2009** as evidenced by the Image File Wrapper document attached as Exhibit C. Applicant agrees with the calculated delay of two (2) days as reflected in the PAIR system's Patent Term Adjustment History, attached as Exhibit B.

Period of adjustment pursuant to 37 C.F.R. § 1.704(c)(10)

Pursuant to 37 C.F.R. § 1.704(c)(10), the period of adjustment shall be reduced by the lesser of: (i) the number of days, if any, beginning on the date a paper was filed after a notice of allowance has been given or mailed and ending on the mailing date of the Office action or notice in response to the paper; or (ii) four months.

A Notice of Allowance was mailed on **March 13, 2009** as evidenced by the Image File Wrapper document attached as Exhibit C. The Notice of Allowance did not include a request for formal drawings. Formal drawings were filed via first class mail on **June 9, 2009**. The drawings were processed in thirty seven days from the Response to Notice of Allowance was received by the U.S. Patent Office on **June 15, 2009** as evidenced by the Patent Term Adjustment History attached as Exhibit B. Applicant agrees with the calculated delay of thirty seven (37) days as reflected in the PAIR system's Patent Term Adjustment History, attached as Exhibit B.

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**Total patent term adjustment**

For the present application, the total patent term adjustment pursuant to 37 C.F.R. § 1.703(f) is the period of adjustment pursuant to 37 C.F.R. § 1.703 reduced by any delays pursuant to 37 C.F.R. § 1.704. Thus, according to our calculations, we believe that the patent term adjustment should be  $(675+71+51)$  days -  $(5 + 2 + 37)$  days = **753** days, instead of **682** days indicated on the Issue Notification attached as Exhibit A.

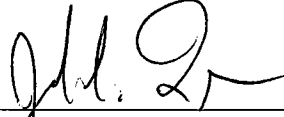
It is respectfully asserted that the patent term adjustment determined by the U.S. Patent and Trademark Office for the present application may not be correct. Accordingly, Applicant's Attorney respectfully requests the U.S. Patent and Trademark office to reconsider, and make revisions to the PAIR system's Patent Term Adjustment History in view of the previous remarks. In addition, it is respectfully requested that the patent term adjustment be re-calculated by the U.S. Patent and Trademark Office in view of the above remarks. Office personnel are invited to contact the undersigned attorney for the Applicant's Attorney via telephone if such communication would be beneficial in fulfilling this request.



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Respectfully submitted,

A handwritten signature in black ink, appearing to read "John C. Freeman", written over a horizontal line.

John C. Freeman

Registration No. 34,483

Attorney for Applicant

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, ILLINOIS 60610  
(312) 321-4200

## EXHIBIT A



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	ISSUE DATE	PATENT NO.	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,738	07/21/2009	7565273	10022/580	2842

28164 7590 07/01/2009  
ACCENTURE CHICAGO 28164  
BRINKS HOFER GILSON & LIONE  
P O BOX 10395  
CHICAGO, IL 60610

## ISSUE NOTIFICATION

The projected patent number and issue date are specified above.

### **Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)** (application filed on or after May 29, 2000)

The Patent Term Adjustment is 682 day(s). Any patent to issue from the above-identified application will include an indication of the adjustment on the front page.

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (571)-272-4200.

APPLICANT(s) (Please see PAIR WEB site <http://pair.uspto.gov> for additional applicants):

Roland Hengerer, Juan Les Pins, FRANCE;

## EXHIBIT B



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## DETERMINATION OF THE AGE, IDENTIFICATION AND SEALING OF A PRODUCT CONTAINING VOLATILE COMPONENTS

Select New Case	Application Data	Transaction History	Image File Wrapper	Patent Term Adjustments	Foreign Priority	Fees	Published Documents	Address & Attorney/Agent	Assignments	Display References
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## Patent Term Adjustment

Filing or 371(c) Date:	01-27-2004	USPTO Delay (PTO) Delay (days):	726
Issue Date of Patent:	07-21-2009	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	44
Post-Issue Petitions (days):	+0	Total Patent Term Adjustment (days):	682
USPTO Adjustment (days):	+0	<a href="#">Explanation Of Calculations</a>	

## Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
07-01-2009	PTA 36 Months	604	
07-21-2009	Patent Issue Date Used in PTA Calculation		
06-18-2009	Dispatch to FDC	⬆	
06-18-2009	Application Is Considered Ready for Issue	⬆	
06-15-2009	Workflow - Drawings Finished		37
06-15-2009	Issue Fee Payment Verified		2
06-15-2009	Issue Fee Payment Received		⬆
03-13-2009	Mail Notice of Allowance		⬆
03-12-2009	Document Verification		
03-12-2009	Notice of Allowance Data Verification Completed		
01-22-2009	Information Disclosure Statement considered		
02-07-2009	Date Forwarded to Examiner		
01-22-2009	Request for Continued Examination (RCE)		
02-07-2009	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)		
01-22-2009	Information Disclosure Statement (IDS) Filed		
01-22-2009	Request for Foreign Priority (Priority Papers May Be Included)		
01-22-2009	Information Disclosure Statement (IDS) Filed		
01-22-2009	Workflow - Request for RCE - Begin		
10-30-2008	Mail Notice of Allowance		
10-28-2008	Notice of Allowance Data Verification Completed		
10-28-2008	Document Verification		
09-24-2008	Date Forwarded to Examiner		
08-26-2008	Response after Non-Final Action		
06-02-2008	Mail Non-Final Rejection		
05-27-2008	Non-Final Rejection		
03-19-2008	Appeal Brief Review Complete		
03-19-2008	Date Forwarded to Examiner		
03-03-2008	Appeal Brief Filed		
01-07-2008	Notice of Appeal Filed		4
01-14-2008	Mail Examiner Interview Summary (PTOL - 413)		⬆
03-08-2007	Examiner Interview Summary Record (PTOL - 413)		⬆
10-03-2007	Mail Non-Final Rejection	51	
09-27-2007	Non-Final Rejection	⬆	
06-18-2007	Date Forwarded to Examiner	⬆	
06-19-2007	Mail Appeals conf. Reopen Prosec.	⬆	
06-14-2007	Pre-Appeals Conference Decision - Reopen Prosecution	⬆	
04-13-2007	Request for Pre-Appeal Conference Filed	⬆	
04-13-2007	Notice of Appeal Filed	⬆	
02-13-2007	Mail Final Rejection (PTOL - 326)		
02-03-2007	Final Rejection		
11-21-2006	Date Forwarded to Examiner		
11-09-2006	Response after Non-Final Action		
09-25-2006	Change in Power of Attorney (May Include Associate POA)		
08-09-2006	Mail Non-Final Rejection		
08-07-2006	Non-Final Rejection		
05-26-2006	Date Forwarded to Examiner		
05-22-2006	Appeal Brief Filed		

05-23-2006	Correspondence Address Change	
03-20-2006	Notice of Appeal Filed	1
12-19-2005	Mail Final Rejection (PTOL - 326)	⬆
12-12-2005	Final Rejection	
09-20-2005	Date Forwarded to Examiner	
09-06-2005	Response after Non-Final Action	
09-06-2005	Miscellaneous Incoming Letter	
09-06-2005	New or Additional Drawing Filed	
06-06-2005	Mail Non-Final Rejection	71
05-31-2005	Non-Final Rejection	⬆
09-22-2004	IFW TSS Processing by Tech Center Complete	⬆
09-22-2004	Case Docketed to Examiner in GAU	⬆
03-08-2004	Information Disclosure Statement (IDS) Filed	⬆
03-08-2004	Information Disclosure Statement (IDS) Filed	⬆
06-12-2004	Application Return from OIPE	⬆
06-12-2004	Application Return TO OIPE	⬆
06-12-2004	Application Dispatched from OIPE	⬆
06-14-2004	Application Is Now Complete	⬆
03-10-2004	Cleared by OIPE CSR	⬆
02-06-2004	IFW Scan & PACR Auto Security Review	⬆
01-27-2004	Initial Exam Team nn	⬆

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Mail Room	Date	Document Code	Document Description	Document Category	Page Count	PDF
	07-01-2009	ISSUE.NTF	<a href="#">Issue Notification</a>	PROSECUTION	1	<input type="checkbox"/>
	06-15-2009	IFEE	<a href="#">Issue Fee Payment (PTO-85B)</a>	PROSECUTION	2	<input type="checkbox"/>
	06-15-2009	TRAN.LET	<a href="#">Transmittal Letter</a>	PROSECUTION	2	<input type="checkbox"/>
	06-15-2009	LET.	<a href="#">Miscellaneous Incoming Letter</a>	PROSECUTION	4	<input type="checkbox"/>
	06-15-2009	DRW	<a href="#">Drawings-only black and white line drawings</a>	PROSECUTION	1	<input type="checkbox"/>
	03-13-2009	NOA	<a href="#">Notice of Allowance and Fees Due (PTOL-85)</a>	PROSECUTION	8	<input type="checkbox"/>
	03-13-2009	BIB	<a href="#">Bibliographic Data Sheet</a>	PROSECUTION	1	<input type="checkbox"/>
	03-13-2009	SRNT	<a href="#">Examiner's search strategy and results</a>	PROSECUTION	14	<input type="checkbox"/>
	03-13-2009	1449	<a href="#">List of References cited by applicant and considered by examiner</a>	PROSECUTION	1	<input type="checkbox"/>
	03-13-2009	FWCLM	<a href="#">Index of Claims</a>	PROSECUTION	1	<input type="checkbox"/>
	03-13-2009	SRFW	<a href="#">Search information including classification, databases and other search related notes</a>	PROSECUTION	1	<input type="checkbox"/>
	03-13-2009	IIFW	<a href="#">Issue Information including classification, examiner, name, claim, renumbering, etc.</a>	PROSECUTION	1	<input type="checkbox"/>
	01-22-2009	RCEX	<a href="#">Request for Continued Examination (RCE)</a>	PROSECUTION	4	<input type="checkbox"/>
	01-22-2009	LET.	<a href="#">Miscellaneous Incoming Letter</a>	PROSECUTION	2	<input type="checkbox"/>
	01-22-2009	TRAN.LET	<a href="#">Transmittal Letter</a>	PROSECUTION	2	<input type="checkbox"/>
	01-22-2009	IDS	<a href="#">Information Disclosure Statement (IDS) Filed (5B/08)</a>	PROSECUTION	1	<input type="checkbox"/>
	01-22-2009	NPL	<a href="#">NPL Documents</a>	PRIOR ART	9	<input type="checkbox"/>
	01-22-2009	FRPR	<a href="#">Certified Copy of Foreign Priority Application</a>	PROSECUTION	16	<input type="checkbox"/>
	01-22-2009	WFEE	<a href="#">Fee Worksheet (PTO-875)</a>	PROSECUTION	1	<input type="checkbox"/>
	10-30-2008	NOA	<a href="#">Notice of Allowance and Fees Due (PTOL-85)</a>	PROSECUTION	8	<input type="checkbox"/>
	10-30-2008	SRFW	<a href="#">Search information including classification, databases and other search related notes</a>	PROSECUTION	1	<input type="checkbox"/>
	10-30-2008	BIB	<a href="#">Bibliographic Data Sheet</a>	PROSECUTION	1	<input type="checkbox"/>
	10-30-2008	SRNT	<a href="#">Examiner's search strategy and results</a>	PROSECUTION	23	<input type="checkbox"/>
	10-30-2008	FWCLM	<a href="#">Index of Claims</a>	PROSECUTION	1	<input type="checkbox"/>
	10-30-2008	IIFW	<a href="#">Issue information including classification, examiner, name, claim, renumbering, etc.</a>	PROSECUTION	1	<input type="checkbox"/>
	08-26-2008	A...	<a href="#">Amendment/Req. Reconsideration-After Non-Final Reject</a>	PROSECUTION	3	<input type="checkbox"/>
	08-26-2008	CLM	<a href="#">Claims</a>	PROSECUTION	4	<input type="checkbox"/>
	08-26-2008	REM	<a href="#">Applicant Arguments/Remarks Made in an Amendment</a>	PROSECUTION	2	<input type="checkbox"/>
	08-26-2008	WFEE	<a href="#">Fee Worksheet (PTO-875)</a>	PROSECUTION	1	<input type="checkbox"/>
	06-02-2008	CTNF	<a href="#">Non-Final Rejection</a>	PROSECUTION	8	<input type="checkbox"/>
	06-02-2008	892	<a href="#">List of references cited by examiner</a>	PRIOR ART	1	<input type="checkbox"/>
	06-02-2008	FWCLM	<a href="#">Index of Claims</a>	PROSECUTION	1	<input type="checkbox"/>
	06-02-2008	SRFW	<a href="#">Search information including classification, databases and other search related notes</a>	PROSECUTION	1	<input type="checkbox"/>
	06-02-2008	BIB	<a href="#">Bibliographic Data Sheet</a>	PROSECUTION	1	<input type="checkbox"/>
	06-02-2008	NPL	<a href="#">NPL Documents</a>	PRIOR ART	25	<input type="checkbox"/>
	03-03-2008	AP.B	<a href="#">Appeal Brief Filed</a>	PROSECUTION	31	<input type="checkbox"/>
	03-03-2008	AP.B	<a href="#">Appeal Brief Filed</a>	PROSECUTION	30	<input type="checkbox"/>
	01-14-2008	EXIN	<a href="#">Examiner Interview Summary Record (PTOL - 413)</a>	PROSECUTION	2	<input type="checkbox"/>
	01-07-2008	N/AP	<a href="#">Notice of Appeal Filed</a>	PROSECUTION	2	<input type="checkbox"/>
	10-03-2007	CTNF	<a href="#">Non-Final Rejection</a>	PROSECUTION	12	<input type="checkbox"/>
	10-03-2007	892	<a href="#">List of references cited by examiner</a>	PRIOR ART	1	<input type="checkbox"/>



10-03-2007	NPL	<a href="#">NPL Documents</a>	PRIOR ART	12	<input type="checkbox"/>
10-03-2007	NPL	<a href="#">NPL Documents</a>	PRIOR ART	4	<input type="checkbox"/>
10-03-2007	NPL	<a href="#">NPL Documents</a>	PRIOR ART	7	<input type="checkbox"/>
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## EXHIBIT D

GRP 30



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10/766,738	01/27/2004	2857	770	426882007800	1	12	2

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 SAN FRANCISCO, CA 94105-2482

JUN 18 2004

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**Applicant(s)**

Roland Hengerer, Juan Les Pins, FRANCE;

**Domestic Priority data as claimed by applicant****Foreign Applications**

EUROPEAN PATENT OFFICE (EPO) 03354007.1 01/28/2003

If Required, Foreign Filing License Granted: 06/12/2004

Projected Publication Date: 09/23/2004

Non-Publication Request: No

Early Publication Request: No

**Title**

Determination of the age, identification and sealing of a product containing volatile components

**Preliminary Class**

702

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Title 37, Code of Federal Regulations, 5.11 & 5.15**

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## EXHIBIT E

**Intellectual Property  
Library**

Source: USPQ, 2d Series (1986 - Present) > U.S. District Courts, District of Columbia > Wyeth v. Dudas, 88 USPQ2d 1538 (D.D.C. 2008)

**88 USPQ2d 1538**  
**Wyeth v. Dudas**  
**U.S. District Court**  
**District of Columbia**

No. 07-1492 (JR)

Decided September 30, 2008

**Headnotes****PATENTS**

[1] Patent grant— Patent term extension; restoration (►105.17)

**JUDICIAL PRACTICE AND PROCEDURE**

**Procedure — Judicial review — Standard of review — Patents (►410.4607.09)**

U.S. Patent and Trademark Office's interpretation of 35 U.S.C. §154(b)(2)(A), which states that, to extent periods of delay in issuance of patent attributable to grounds specified in Section 154(b) overlap, period of patent term adjustment shall not exceed actual number of days issuance of patent was delayed, is not entitled to wide deference in accordance with *Chevron U.S.A. Inc. v. Natural Resources Defense Council Inc.*, 467 U.S. 837 (1984), since Section 154(b)(3)(A) states that authority of PTO is limited to prescribing "regulations establishing procedures for the application for and determination of patent term adjustments under this subsection," and PTO thus has not been granted power to elaborate on meaning of Section 154(b)(2)(A).

**PATENTS**

[2] Patent grant— Patent term extension; restoration (►105.17)

**Practice and procedure in Patent and Trademark Office — Prosecution — Rules and rules practice (►110.0905)**

Provisions of 35 U.S.C. §154(b)(2)(A), which state that, to extent periods of delay in issuance of patent attributable to grounds specified in Section 154(b) overlap, period of patent term adjustment shall not exceed actual number of days issuance of patent was delayed, have been improperly construed by U.S. Patent and Trademark Office to mean that period of delay under Section 154(b)(1)(B) runs from filing date of application, such that period of "B delay" always overlaps with any period of delay under Section 154(b)(1)(A), since language of statute provides that period of "B delay" begins when PTO has failed to issue patent within three years after filing date of application, not before, and since interpretation of statute must square with language therein, even if doing so may lead to "windfall" extensions of patent term.

**Case History and Disposition**

Action by Wyeth and Elan Pharma International Ltd. against Jon W. Dudas, in his capacity as Under Secretary of Commerce for Intellectual Property and Director of U.S. Patent and Trademark Office, challenging PTO's interpretation of 35 U.S.C. §154(b), which governs adjustments to length of patent term. PTO is held to have improperly construed statute.

**Attorneys**

David O. Bickart, of Kaye Scholer, Washington, D.C.; Patricia A. Carson, of Kaye Scholer, New York, N.Y., for plaintiffs.

Fred Elmore Haynes, U.S. attorney's office, Washington, for defendant.

## Opinion Text

### Opinion By:

Robertson, J.

Plaintiffs here take issue with the interpretation that the United States Patent and Trademark Office (PTO) has imposed upon 35 U.S.C. §154, the statute that prescribes patent terms. Section 154(a)(2) establishes a term of 20 years from the day on which a successful patent application is first filed. Because the

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clock begins to run on this filing date, and not on the day the patent is actually granted, some of the effective term of a patent is consumed by the time it takes to prosecute the application. To mitigate the damage that bureaucracy can do to inventors, the statute grants extensions of patent terms for certain specified kinds of PTO delay, 35 U.S.C. §154(b)(1)(A), and, regardless of the reason, whenever the patent prosecution takes more than three years. 35 U.S.C. §154(b)(1)(B). Recognizing that the protection provided by these separate guarantees might overlap, Congress has forbidden double-counting: "To the extent that periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed." 35 U.S.C. §154(b)(2)(A). Plaintiffs claim that the PTO has misconstrued or misapplied this provision, and that the PTO is denying them a portion of the term Congress has provided for the protection of their intellectual property rights.

### Statutory Scheme

Until 1994, patent terms were 17 years from the date of issuance. See 35 U.S.C. §154 (1992) ("Every patent shall contain ... a grant ... for the term of seventeen years ... of the right to exclude others from making, using, or selling the invention throughout the United States..."). In 1994, in order to comply with treaty obligations under the General Agreement on Tariffs and Trade (GATT), the statute was amended to provide a 20-year term from the date on which the application is first filed. See Pub. L. No. 103-465, §532, 108 Stat. 4809, 4984 (1994). In 1999, concerned that extended prosecution delays could deny inventors substantial portions of their effective patent terms under the new regime, Congress enacted the American Inventors Protection Act, a portion of which -- referred to as the Patent Term Guarantee Act of 1999 -- provided for the adjustments that are at issue in this case. Pub. L. No. 106-113, §§4401-4402, 113 Stat. 1501, 1501A-557 (1999).

As currently codified, 35 U.S.C. §154(b) provides three guarantees of patent term, two of which are at issue here. The first is found in subsection (b)(1)(A), the "[g]uarantee of prompt Patent and Trademark Office response." It provides a one-day extension of patent term for every day that issuance of a patent is delayed by a failure of the PTO to comply with various enumerated statutory deadlines: fourteen months for a first office action; four months to respond to a reply; four months to issue a patent after the fee is paid; and the like. See 35 U.S.C. §154(b)(1)(A)(i)-(iv). Periods of delay that fit under this provision are called "A delays" or "A periods." The second provision is the "[g]uarantee of no more than 3-year application pendency." Under this provision, a one-day term extension is granted for every day greater than three years after the filing date that it takes for the patent to issue, regardless of whether the delay is the fault of the PTO.<sup>1</sup> See 35 U.S.C. §154(b)(1)(B). The period that begins after the three-year window has closed is referred to as the "B delay" or the "B period." ("C delays," delays resulting from interferences, secrecy orders, and appeals, are similarly treated but were not involved in the patent applications underlying this suit.)

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<sup>1</sup> Certain reasons for exceeding the three-year pendency period are excluded, see 35 U.S.C. §154(b)(1)(b)(i)-(iii), as are periods attributable to the applicant's own delay. See 35 U.S.C. §154(b)(2)(C).

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The extensions granted for A, B, and C delays are subject to the following limitation:

(A) *In general.*—To the extent that periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

35 U.S.C. §154(b)(2)(A). This provision is manifestly intended to prevent double-counting of periods of delay, but understanding that intent does not answer the question of what is double-counting and



what is not. Proper interpretation of this proscription against windfall extensions requires an assessment of what it means for "periods of delay" to "overlap."

The PTO, pursuant to its power under 35 U.S.C. §154(b)(3)(A) to "prescribe regulations establishing procedures for the application for and determination of patent term adjustments," has issued final rules and an "explanation" of the rules, setting forth its authoritative construction of the double-counting provision. The rules that the PTO has promulgated essentially parrot the statutory text, see 37 C.F.R. §1.703(f), and so the real interpretive act is found in something the PTO calls its Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A), which was published on June 21, 2004, at 69

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Fed. Reg. 34238. Here, the PTO "explained" that:

the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. §154(b)(1)(B), *the entire period during which the application was pending before the Office* (except for periods excluded under 35 U.S.C. §154(b)(1)(B) (i)-(iii)), and not just the period beginning three years after the actual filing date of the application, *is the relevant period under 35 U.S.C. §154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).*

69 Fed. Reg. 34238 (2004) (emphasis added). In short, the PTO's view is that any administrative delay under §154(b)(1)(A) overlaps any 3-year maximum pendency delay under §154(b)(1)(B): the applicant gets credit for "A delay" or for "B delay," whichever is larger, but never A + B.

In the plaintiffs' submission, this interpretation does not square with the language of the statute. They argue that the "A period" and "B period" overlap only if they occur on the same calendar day or days. Consider this example, proffered by plaintiff: A patent application is filed on 1/1/02. The patent issues on 1/1/08, six years later. In that six-year period are two "A periods," each one year long: (1) the 14-month deadline for first office action is 3/1/03, but the first office action does not occur until 3/1/04, one year late; (2) the 4-month deadline for patent issuance after payment of the issuance fee is 1/1/07, but the patent does not issue until 1/1/08, another year of delay attributable to the PTO. According to plaintiff, the "B period" begins running on 1/1/05, three years after the patent application was filed, and ends three years later, with the issuance of the patent on 1/1/08. In this example, then, the first "A period" does not overlap the "B period," because it occurs in 2003-04, not in 2005-07. The second "A period," which covers 365 of the same days covered by the "B period," does overlap. Thus, in plaintiff's submission, this patent holder is entitled to four years of adjustment (one year of "A period" delay + three years of "B period" delay). But in the PTO's view, since "the entire period during which the application was pending before the office" is considered to be "B period" for purposes of identifying "overlap," the patent holder gets only three years of adjustment.

#### **Chevron Deference**

We must first decide whether the PTO's interpretation is entitled to deference under *Chevron v. NRDC*, 467 U.S. 837 (1984). No, the plaintiffs argue, because, under the Supreme Court's holdings in *Gonzales v. Oregon*, 546 U.S. 243 (2006), and *United States v. Mead Corp.*, 533 U.S. 218 (2001), Congress has not "delegated authority to the agency generally to make rules carrying the force of law," and in any case the interpretation at issue here was not promulgated pursuant to any such authority. See *Gonzales*, 546 U.S. at 255-56, citing *Mead*, 533 U.S. at 226-27. Since at least 1996, the Federal Circuit has held that the PTO is not afforded *Chevron* deference because it does not have the authority to issue substantive rules, only procedural regulations regarding the conduct of proceedings before the agency. See *Merck & Co. v. Kessler*, 80 F.3d 1543, 1549-50 [38 USPQ2d 1347] (Fed. Cir. 1996).

[ 1 ] Here, as in *Merck*, the authority of the PTO is limited to prescribing "regulations establishing procedures for the application for and determination of patent term adjustments under this subsection." 35 U.S.C. §154(b)(3)(A) (emphasis added). Indeed, a comparison of this rulemaking authority with the authority conferred for a different purpose in the immediately preceding section of the statute makes it clear that the PTO's authority to interpret the overlap provision is quite limited. In 35 U.S.C. §154(b)(2)(C)(iii) the PTO is given the power to "prescribe regulations establishing the circumstances that constitute a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application" (emphasis added) -- that is, the power to elaborate on the meaning of a particular statutory term. No such power is granted under §154(b)(3)(A). *Chevron*

deference does not apply to the interpretation at issue here.

### **Statutory Construction**

*Chevron* would not save the PTO's interpretation, however, because it cannot be reconciled with the plain text of the statute. If the statutory text is not ambiguous enough to permit the construction that the agency urges, that construction fails at *Chevron*'s "step one," without regard to whether it is a reasonable attempt to reach a result that Congress might have intended. See, e.g., *MCI v. AT&T*, 512 U.S. 218, 229 (1994) ("[A]n agency's interpretation of a statute is not entitled to deference

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when it goes beyond the meaning that the statute can bear.").

[ 2 ] The operative question under 35 U.S.C. §154(b)(2)(A) is whether "periods of delay attributable to grounds specified in paragraph (1) overlap." The only way that periods of time can "overlap" is if they occur on the same day. If an "A delay" occurs on one calendar day and a "B delay" occurs on another, they do not overlap, and §154(b)(2)(A) does not limit the extension to one day. Recognizing this, the PTO defends its interpretation as essentially running the "period of delay" under subsection (B) from the filing date of the patent application, such that a period of "B delay" *always overlaps* with any periods of "A delay" for the purposes of applying §154(b)(2)(A).

The problem with the PTO's construction is that it considers the application *delayed* under §154(b)(1)(B) during the period *before it has been delayed*. That construction cannot be squared with the language of §154(b)(1)(B), which applies "if the issue of an original patent is *delayed* due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years." (Emphasis added.) "B delay" begins when the PTO has failed to issue a patent within three years, not before.

The PTO's interpretation appears to be driven by Congress's admonition that any term extension "not exceed the actual number of days the issuance of the patent was delayed," and by the PTO's view that "A delays" during the first three years of an applications' pendency inevitably lead to "B delays" in later years. Thus, as the PTO sees it, if plaintiffs' construction is adopted, one cause of delay will be counted twice: once because the PTO has failed to meet an administrative deadline, and again because that failure has pushed back the entire processing of the application into the "B period." Indeed, in the example set forth above, plaintiffs' calendar-day construction does result in a total effective patent term of 18 years under the (B) guarantee, so that – again from the PTO's viewpoint – the applicant is not "compensated" for the PTO's administrative delay, he is benefitted by it.

But if subsection (B) had been intended to guarantee a 17-year patent term and *no more*, it could easily have been written that way. It is true that the legislative context – as distinct from the legislative history – suggests that Congress may have intended to use subsection (B) to guarantee the 17-year term provided before GATT. But it chose to write a "[g]uarantee of no more than 3-year application pendency," 35 U.S.C. §154(b)(1)(B), not merely a guarantee of 17 effective years of patent term, and do so using language separating that guarantee from a different promise of prompt administration in subsection (A). The PTO's efforts to prevent windfall extensions may be reasonable – they may even be consistent with Congress's intent – but its interpretation must square with Congress's words. If the outcome commanded by that text is an unintended result, the problem is for Congress to remedy, not the agency.

- End of Case -

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